

REMARKS

Entry of claim amendments

Applicant's attorney thanks the Examiner and supervising Examiner for granting the telephone conference on September 15, 2005 to discuss the rejections of claims 1-11 and 24 under 35 U.S.C. § 101. *Agreement was reached to amend the preambles to those claims to address the section 101 rejections.* The foregoing amendments to the preambles of claims 1-11 and 24 are made pursuant to the agreement reached with the Examiners. The preamble to claim 29 has been amended in a similar manner. Therefore, applicant respectfully requests entry of those amendments and withdrawal of the rejections under section 101.

The additional amendments to the claims are explained below and should be entered because they place the claims in condition for allowance or, at the very least, reduce the number of issues for appeal.

Independent claims 1, 7, 12, 18 and 24 have been amended by incorporating, respectively, the features of dependent claims 30, 32, 34, 36 and 38, which have been canceled.

Claims 31, 33, 35, 37 and 39, which previously depended from the canceled claims, have been amended to depend, respectively, from independent claims 1, 7, 12, 18, 24 and 28.

Claims 6, 17, 23 and 29 have been re-written in independent form to include the features of the respective claim from which they depended. For example, claim 6 has been amended to incorporate the features of claim 1 (prior to amendment). Similarly, claim 17 has been amended to incorporate the features of claim 12 (prior to amendment). Likewise, claim 23 has been amended to incorporate the features of claim 18 (prior to amendment), and claim 29 has been amended to include the features of claim 24 (prior to amendment).

In view of the foregoing remarks, applicant respectfully requests entry of the amendments.

The claims are patentable over the cited references

In the final action, the claims were rejected under 35 U.S.C. § 103 as follows:

(1) Claims 1-5, 7-17, 18-22, 24-28 and 30-39 were rejected as unpatentable over U.S. Patent No. 6,192,396 (Kohler) in view of U.S. Patent No. 5,903,723 (Beck et al.).

(2) Claims 6, 17, 23 and 29 were rejected as unpatentable over the Kohler patent in view of the Beck et al. patent in further view of U.S. Patent No. 5,917,489 (Thurlow et al.).

(A) Claims 1-5, 7-17, 18-22, 24-28, 31, 33, 35, 37 and 39

As explained above, independent claim 1 has been amended to incorporate the features of claim 30 (now canceled). Thus, claim 1 recites, in part, that when the machine-readable instructions are executed by the machine, the machine enables the sender of a message to designate at least one recipient to receive the message and the attachment, enables the sender to designate at least one recipient to receive the message without the attachment, and incorporates an icon *in the message without the attachment*. The icon is indicative of the attachment sent to the recipient(s) who receive the message with the attachment.

An example of incorporating an icon into a message without an attachment is discussed in the specification as follows:

Figure 8 shows the process by which the recipient list is processed to enable split distribution of attachments in accordance with a preferred embodiment of the present invention. As shown in the figure, recipient list 150 is examined at step S200 and sorted by attachment designation. The recipients that have been designated as "with attachment" are added to recipients to receive attachments 160 and at step S250 the message and attachment or attachments are sent. Those recipients that have been designated as "without attachment" are added to recipients not receiving attachments 170 and at step S300 have the attachment removed from the message. Next, at step S400, the name of the attachment is stored, at step S500 a ghost icon is created and named for the name of the attachment that will not be sent, and, at step S600, the ghost icon is inserted into

the message to replace the file. Next, at step S700, the message is sent with the icon but without the attached file.

(Specification, page 21, line 27 – page 22, line 13) Thus, according to claim 1, a recipient who receives the message without the attachment will, nevertheless, receive the icon in the message.

The Office action (page 7, par. 23) points to col. 11, lines 62-65 of the Kohler patent as allegedly disclosing or suggesting the claimed “icon” feature. That is incorrect.

The Kohler patent discloses a technique that allows different portions of an e-mail message (with or without attachments) to be sent selectively to various recipients. If the message received by a particular recipient includes an attachment, then the presence of the attachment is indicated by an icon that appears in the message.

Although the Kohler patent discloses the use of icons to indicate the presence of an attachment in the e-mail message, such an icon is sent only to those recipients of the message who receive the attachment. The icon is not included in the message of those recipients who do not receive the attachment. As explained by the Kohler patent:

If a command has been given to send the message, flow proceeds to step S1114.

In step S1114, E-mail editor 31 generates [*sic.*] separate messages corresponding to each subset of identified recipients. For example, for the message shown in FIG. 6, separate messages are made for the following groups of recipients: (1) "Team Member 2" and "Team Member 3"; (2) "Team Member 1", "Manager" and "President"; and (3) "Manager" and "President". *Each separate message contains only those input portions associated with the corresponding identified subset of recipients.*

(Col. 11, lines 28-38; italics added)

The Kohler patent also discloses an “as-received” mode that allows the sender to view the message as it will be received by a particular recipient:

The recipient of the message also may desire to view the message as it is received by other recipients (i.e., those who received less of the whole message than did the recipient in question).

Of course, when the message is viewed in the as-received mode, *only those parts of the message received by both the user and the identified recipient(s) are displayed.*

(Col. 9, lines 36-43)

The section of the Kohler patent (col. 11, lines 62-65) pointed to by the Office action simply explains the operation of the e-mail reader in performing a viewing operation (*i.e.*, when a recipient chooses to view a received message). If the message received by the particular recipient includes an attachment, then an icon will be displayed to alert the recipient to the presence of the attachment. If, however, the message received by the particular recipient does not include the attachment, then the icon would not be displayed because there would be no attachment associated with that message.

Therefore, the Kohler patent does not disclose or suggest that a recipient who receives the message without the attachment will, nevertheless, receive the icon in the message, as recited in claim 1. To the contrary, the Kohler patent clearly indicates that the message displayed to such a recipient would not include an icon in place of the attachment.

The Beck et al. patent also fails to disclose or suggest the "icon" feature as recited in claim 1. Therefore, neither the Kohler patent nor the Beck et al. patent, taken alone or together, suggests the subject matter of claim 1 as a whole.

At least for the foregoing reasons, independent claim 1, as well as dependent claims 2-11 and 31, should be allowed.

Independent claims 7, 12, 18 and 24 recite an "icon" feature similar to that recited in claim 1. Therefore, those claims, as well as their respective dependent claims, also should be allowed.

(B) Claims 6, 17, 23 and 29

Independent claim 6 recites that when the instructions are executed by the machine, the machine enables each recipient to create and edit a recipient profile that includes the recipient's preferences with regard to "receipt of" prospective attachments. As explained in the specification at page 8:

[T]here is a need for an e-mail program that can allow a user to more precisely specify the type of information that each of the intended recipients will receive. Examples of a recipient's preferences with regard to the receipt of prospective attachments are described in the specification at page 20 as follows:

At the recipient side, potential recipients can select from reception options with regard to receipt of attachments to form a reception profile. For example, users of the e-mail system can specify that they cannot receive attachments larger than a particular size. Preferably, other options can be selected. The program preferably can be set such that certain dates will be blackened out with regard to reception of attachments. For example, if the recipient will be out of town for a two week period, he or she can select to accept no attachments during that period, or no attachments except for those sent from a particular sender or senders.

As further explained in the examples at page 19:

In some situations, certain recipients simply cannot accept certain messages. In such a situation, the program [] advantageously provides for an absolute block to be set in relation to users who have a known restriction on permitted attachments size. For example, many company firewalls restrict e-mail transmissions to a certain size (such as 2 megabytes) – the program [] then designates users on that system so as to never to be sent a file whose attachments exceed the specified size, . . .

Thus, the profile regarding the recipient's preferences relates to "receipt" of prospective attachments—*i.e.*, whether or not a particular attachment should be sent for receipt by the recipient.

The Office action refers to col. 7, lines 54-58, col. 10, lines 55-67 and Table I at col. 11 of the Thurlow et al. patent as allegedly disclosing the claimed profile. That is incorrect.

The disclosure at col. 7 of the Thurlow et al. patent reads as follows:

MAPI also employs "profiles," which are collections of information about the message services and service providers that a user of a client application 300 wants to be available during a particular MAPI session. Every user has at least one profile. Multiple profiles may be used in some cases. For example, a user might have one profile to work with a server-based message store service and another profile to work with a message store service on the local computer. A user may have profiles on more than one computer. Similarly, a computer may store profiles for more than one user. Profiles provide a flexible way to select combinations of message systems.

As is illustrated in FIG. 2 of the Thurlow et al. patent, the applications 300 include a spreadsheet, word processing, work flow and mail. Thus, it is clear that the "profiles" referred to in the Thurlow et al. patent have nothing to do with a recipient's preferences regarding receipt of attachments as recited in the pending claims. Instead, the "profiles" in the Thurlow et al. patent relate to the computer services and service providers that a user of the application 300 wants to be available during a particular session

The disclosure at columns 10-12 of the Thurlow et al. patent describes how a user may select particular conditions (Table I) and specify particular actions (Table II) that are to be applied with respect to a received message when the particular conditions are satisfied. The list of actions in Table II (*e.g.*, file it, delete it, forward it, reply, notify, tag it, clear, assign, play a

file, mark it) indicates how the message is to be handled *after the message is received*. Claim 6, however, does not recite “the profile including the recipient’s preferences with regard to handling of prospective attachments.” Indeed, none of the conditions and actions listed in Tables I and II or disclosed elsewhere in the Thurlow et al. patent suggests the circumstances under which a message or attachment should be sent for receipt. Therefore, neither the Thurlow et al. patent nor the other cited references discloses or suggests a profile that includes the recipient’s preferences with regard to “receipt of prospective attachments.”

At least for the foregoing reasons, claim 6 should be allowed. Claims 17, 23 and 29 recite similar features and also should be allowed for the same reasons.

Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant respectfully requests entry of the amendments and allowance of the claims.


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